

III. REMARKS

1. Claims 1, 3-5, 9, and 11-17 remain in the application. Claims 2, 6-8, and 10 have been cancelled without prejudice. Claims 1, 9, and 14 have been amended.

2. Applicants wish to thank the Examiner for the detailed analysis of the claims and the in depth explanation of the rejection set forth in the present action.

3. Applicants respectfully submit that claims 1 and 5 are patentable over the combination of Crowley (US 5,193,727), Allen et al. (US 6,549,299, "Allen"), and Kurahashi et al. (US 2003/0222396, "Kurahashi") under 35 USC 103(a).

The combination of Crowley, Allen, and Kurahashi fails to disclose or suggest recording the post processing instructions on a transportable electronic information device without marking any media with the post processing instructions, as recited by claim 1.

Allen discloses a document printing and finishing system that prints document sheets and an instruction sheet. The instruction sheet includes computer readable finishing instructions. The post processing instructions are not recorded on a transportable electronic information device but instead are printed on a sheet of media.

Crowley is directed to a system that incorporates post production operations in the production of a continuous stream of images upon a web. A determination system 44 transfers post production commands to a post production device 48. However, the post processing instructions are not recorded on a transportable electronic information device, and the transportable electronic information device is not transported with the printed media.

Kurahashi discloses a storage device 1202 attached to a stacker tray 1207 that stores post processing information.

Combining Crowley, Allen, and Kurahashi does not result in removing any of the features of Allen, in particular those related to printing post processing instructions on a

sheet of media. Thus, the combination still fails to disclose or suggest recording the post processing instructions on a transportable electronic information device without marking any media.

Applicants note that according to MPEP 2143.01 V. and VI., any proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. Thus, the functionality of Crowley, Allen, and Kurahashi must be preserved when combining them.

At least for these reasons, Applicants submit that the combination Crowley, Allen, and Kurahashi fails to render independent claim 1 and dependent claim 5 unpatentable.

4. Applicants respectfully submit that claims 3 and 4 are patentable over the combination of Crowley, Allen, and Kurahashi in view of Webster et al. (US 5,559,606, "Webster") under 35 USC 103(a).

Claims 3 and 4 depend from claim 1.

The addition of Webster to the combination of Crowley, Allen, and Kurahashi fails to eliminate any features of Allen, in particular those related to printing post processing instructions on a sheet of media. Therefore, the cited combination fails to claims 3 and 4 unpatentable for the same reasons argued in favor of claim 1.

5. Applicants respectfully submit that claims 9, 13, 14, 16, and 17 are patentable over the combination of Murata, Crowley, Allen, and Kurahashi under 35 USC 103(a).

The combination of Murata, Crowley, Allen, and Kurahashi fails to disclose or suggest an online printing/copying operation having a controller for determining post processing instructions for printed media and for recording the post processing instructions on a transportable electronic information device without marking any media with the post processing instructions, as recited by claim 9.

Combining Crowley, Allen, and Kurahashi with Murata does not result in removing any of the features of Allen, in particular those related to printing post processing

instructions on a sheet of media. Thus, the combination of Murata, Crowley, Allen, and Kurahashi would still include printing post processing instructions on a sheet of media and therefore fail to disclose or suggest an online printing/copying operation having a controller for recording the post processing instructions on a transportable electronic information device without marking any media with the post processing instructions.

At least for these reasons, the combination of Murata, Crowley, Allen, and Kurahashi fails to disclose or suggest the features of claim 9.

Claim 13 depends from claim 9 and is patentable at least because of its dependency.

Claim 14 is directed to subject matter similar to claim 1. The combination of Murata, Crowley, Allen, and Kurahashi fails to disclose all the features of claim 14 for the same reasons argued above supporting claim 1.

Claims 16 and 17 depend from claim 14 and are patentable at least because of their dependencies.

6. Applicants respectfully submit that claims 11, 12, and 15 are patentable over the combination of Murata, Crowley, Allen, Kurahashi, and Webster under 35 USC 103(a).

Claims 11 and 12 depend from claim 9.

The addition of Webster to the combination of Murata, Crowley, Allen, and Kurahashi does not result in removing any of the features of Allen, in particular those related to printing post processing instructions on a sheet of media. Thus, the combination of Murata, Crowley, Allen, Kurahashi, and Webster would still include printing post processing instructions on a sheet of media and therefore fail to disclose or suggest an online printing/copying operation having a controller for recording the post processing instructions on a transportable electronic information device without marking any media, with the post processing instructions as recited by claim 9.

Therefore, claims 11 and 12 are at least patentable over the combination of Murata, Crowley, Allen, Kurahashi, and Webster because of their dependencies.

Claim 15 depends from claim 14 and is patentable over the combination of Murata, Crowley, Allen, Kurahashi, and Webster because of its dependency.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

/jvg44695/
Joseph V. Gamberdell, Jr.
Reg. No. 44,695

16 February 2009
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512